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10/502,447	03/07/2005	Veronique Ferrari	05725.1370	3679

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EXAMINER

PARK, HAEJIN S

ART UNIT	PAPER NUMBER
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1611

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/502,447	Applicant(s) FERRARI, VERONIQUE
	Examiner H. SARAH PARK	Art Unit 1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-84 is/are pending in the application.
- 4a) Of the above claim(s) 38,39,43,52-61 and 79-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-37,40-42,44-51 and 62-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/17/2011</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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DETAILED ACTION

The amendments and arguments filed on May 17, 2011 are acknowledged and have been fully considered. Claims 35 – 36, 50 – 51, and 78 are amended and claim 64 is cancelled. Claims 35 – 37, 40 – 42, 44 – 51, 62 – 63, 65 – 78 are now pending and under consideration.

OBJECTIONS/REJECTIONS WITHDRAWN

The objections to claims 50 – 51 and 67 are withdrawn in view of the claim amendments.

The rejection of claim(s) 35 – 37, 40 – 42, 44 – 63, 65 – 76, and 78 under 35 U.S.C. 103(a) based on Tournilhac, Bitler, and Stewart is withdrawn in view of the claim amendment(s).

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1611

2. Claims 35 – 37, 40 – 42, 44 – 63, 65 – 76, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bitler (WO 01/19333 A1 published on March 22, 2001, #15 on IDS of March 17, 2005) in view of Tournilhac (EP 1034776 A1 published on September 13, 2000, English machine translation is relied on for citations) as evidenced by Stewart (U.S. Patent no. 5,156,911 issued on October 20, 1992).

3. Concerning claims 35 and 78, Bitler teaches compositions useful for cosmetics such as lipsticks, nail varnishes, and fragrances, comprising oil phase and polymeric thickeners having side chain crystalline polymers (SCC polymers) (title; abstract; p.7 ll.23-29, 31). Bitler further teaches that the SCC polymers are soluble in oil phase at temperatures above peak melting temperature T_p (Title; abstract). The T_p is preferably not more than 20 degrees Celsius above the temperature of use, and Bitler discloses specific examples with T_p 's of, e.g., 48, 39, and 29 degrees Celsius (p.2 ll.11-12; p.6 ll.16-18; p.9, Table 1 examples 1, 4, and 6). **Bitler moreover teaches that “depending on the expected temperature of use, T_p may be from 0-150 °C. generally 10-100 °C, for example 40-80 °C”** (p.6 ll.26-28). The SCC polymers specifically include homopolymers and copolymers derived from methacrylic and acrylic monomers and fluorinated methacrylates among others (p.4 ll.10-18; p.5 ll.17-24).

Concerning claims 50 – 51, Bitler teaches that the SCC polymers have molecular mass ranging from 10,000 to 1,500,000 (p.3 ll.20-23), overlapping and thus making prima facie obvious the instantly claimed ranges.

Concerning claim 52, Bitler teaches that the SCC polymers are soluble in oil at temperatures above peak melting temperature T_p (Title; abstract).

Concerning claims 54 – 61, Bitler specifies that the SCC polymers “used in the present invention are in themselves are well known” (p.4 l.1) as disclosed in Stewart and the collection of non-patent literature listed at page 4, lines 4 – 9, which are also cited in Stewart (col.6 l.59 – col.7 l.13).

Specifically as to claim 54, Stewart teaches side chain crystallizable polymers where monomer units X have a side chain defined by “S” and “C” where “S” and “C” are named as linear aliphatic side chains of at least 10 carbon atoms (col.5 l.67 – col.6 l.48). It is the position of the examiner that a side chain having a large carbon chain would be hydrophobic.

As to claim 55, Stewart teaches the semi-crystalline polymer having M as a backbone atom, S as a spacer, C as a crystallizable group where S–C can be fluorinated aliphatic chains of at least 6 carbons (col.6 ll.5-48).

As to claims 56 – 61, Stewart teaches that the side-chain crystallizable polymers contain typical monomer “X” and “Y” units comprise acrylic acid, methacrylic acid, C14-C22 acrylates or methacrylates, vinyl ethers or esters, alpha olefins and hydrophilic monomers (col. 6 ll. 5-48; col. 7 ll.29-35). Stewart further teaches monomer “Z” may be included in the polymers, where monomer “Z” may be hydroxyethylacrylate or methacrylamide (col.6 ll.17-29).

Concerning claims 62 – 63 and 71 – 72, Bitler teaches that usually the amount of the SCC polymer can be up to 10% of the total composition (p.6 l.30 – p.7 l.2).

Art Unit: 1611

Concerning claim 67, Bitler teaches SCC polymers having melting temperatures ranging from 29 to 48 degrees Celsius (p.9 Table 1, examples 1, 4, 6-8), overlapping and thus making prima facie obvious the instantly claimed range. The Applicant moreover explicitly references Bitler as disclosing the “low-melting polymers” used in the compositions of the instant claims (para.0080)

Concerning claims 75 – 76 and 78, Bitler teaches that the SCC polymers of the invention are particularly useful for cosmetics such as lipsticks (p.7 ll.23-24).

Bitler et al. does not expressly discuss incorporating a colorant, volatile oil, or a liquid fatty phase structured with an SCC polymers having a melting temperature of at least 50 °C, however as noted above Bitler teaches that its compositors are useful specifically for oil-containing lipsticks, nail varnishes, and fragrances, which one of ordinary skill in the art would readily appreciate contain colorants and volatile oils.

4. Tournilhac teaches cosmetic compositions comprising a liquid fatty phase and a semi-crystalline olefin (i.e., crystallinity from 5 to 40%) (para.0010), a coloring matter (para.0014), and a volatile oil such as isododecane (paras.0066-67). Tournilhac further teaches that the olefin copolymer has a melting point lower than 150 degrees Celsius, preferably lower than or equal to 110 degrees Celsius (para.0020). Tournilhac specifically teaches using perfluorinated or fluorinated homo- and copolymers, including perfluorinated (meth)acrylic homopolymers or copolymers, perfluorinated homo- or vinylic copolymers, and fluorinated poly(ether vinylic) homo or olefin copolymers (para.0092). Tournilhac teaches that compositions comprising the olefin

Art Unit: 1611

polymers it teaches do not migrate over skin surface, present a glossy appearance, resist water, and stays on throughout the day (paras.0007-09).

Concerning claim 36 – 37 and 40 – 42, Tournilhac teaches isododecane (para.0066). Isododecane has a boiling point at atmospheric pressure of less than 220 degrees Celsius as evidenced by the isododecane MSDS already made of record (see PTO-892 of April 20, 2009).

Concerning claims 44 – 45, Tournilhac teaches use of volatile oils in an amount ranging from 30 to 97.99% of the total weight of the composition (para.0069), overlapping and thus making prima facie obvious the instantly claimed ranges. See MPEP §2144.05.

Concerning claims 46 – 49, Tournilhac does not appear to teach the specific ranges of concentration by reference to the liquid fatty phase or the semi-crystalline polymer. It would however have been prima facie obvious to one having ordinary skill in the art at the time of the invention to optimize the ranges of the ingredients of the claims. One would have been motivated to do so dependent upon the desired final properties of the formulation (i.e. skin feel, thickness of composition, etc.) and further motivated by the suggestion of Tournilhac that the amount of oil can be varied from 30 to 97.99 % by weight while still obtaining successful results (para.0069). It has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See MPEP §2144.05.

Concerning claims 50 – 51, Tournilhac teaches that the polymers of the invention have a molecular mass of greater than 30,000 (para.0021), overlapping and thus making prima facie obvious the instantly claimed ranges.

Concerning claim 52, Tournilhac teaches the polymers can be solubilized in the fatty phase by heating it to the top of its melting point (para.0037).

Concerning claim 53, Tournilhac teaches olefin copolymers with controlled crystallinity (para.0016) including block copolymers of polyolefins (para.0089).

Concerning claims 56, 57, and 60 – 61, as noted above Tournilhac teaches the use of homopolymers or copolymers of methacrylate and polyisobutylene, perfluorinated homo- or vinylic copolymers of methacrylate, and polyvinylpyrrolidone derivatives or copolymers (paras 0062-63, 0091-92).

Concerning claims 62 – 63, Tournilhac teaches that the polymers are present in an amount ranging from 5% to 70% by weight (para.0036), overlapping and thus making prima facie obvious the instantly claimed ranges.

Concerning claims 65 – 66, Tournilhac teaches that the polymers have a melting point of lower than 150 degrees Celsius, preferably lower than 110 degrees Celsius (para.0020).

Concerning claim 70, Tournilhac teaches use of isononyl isononanoate and polar oils and further that more than one oil may be used (paras.0065-66).

Concerning claims 71 – 72, Tournilhac teaches that the amount of the polymers can be varied from 5 to 70% by weight (para.0036).

Art Unit: 1611

Concerning claim 73, Tournilhac teaches that waxes are present in the amount ranging from 0 to 50% by weight (para.0087), overlapping and thus making prima facie obvious the claimed range of "less than 10%." Further, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to include a lower amount of wax motivated by the teaching of Tournilhac that the rate of crystallinity of waxes is not easily controlled and large crystallites may be present when wax is used (para.0004).

Concerning claim 74, Tournilhac teaches that the compositions are preferably anhydrous (para.0094).

Concerning claim 75, Tournilhac teaches that the product can be presented in a cast form (para.0093). Moreover it is noted the casting form is directed to a process for making the product rather than the product itself and as such does not further define or limit the product structurally.

Concerning claim 76, Tournilhac teaches lipstick, eyeliners, foundations, et cetera (paras.0002, 0093).

Concerning claim 78, Tournilhac teaches a makeup composition comprising a liquid fatty phase having an effective amount of semi-crystalline olefin polymers (crystallinity from 5 to 40%) (para.0010), a pigment (para.0014), where the liquid fatty phase is dispersed in a volatile oil such as isododecane (paras.0066-67). Tournilhac teaches that the polymers have a melting point of lower than 150 degrees Celsius, preferably lower than 110 degrees Celsius (para.0020). Tournilhac further teaches the compositions in the form of a lipstick (paras.0002 and 0093).

5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bitler and Tournilhac and prepare cosmetic compositions comprising liquid fatty phases structured with SCC polymers having melting temperature of less than 50 °C and above °C.

One would have been motivated to do so because both Bitler and Tournilhac are drawn to oil-containing compositions comprising partially crystalline polymeric thickeners that are also safe and effective for cosmetic use. Moreover Bitler teaches using SCC polymers with T_p ranging from 0 – 150 °C or 40 – 80 °C depending on the expected temperature of use, including those prepared by polymerizing perfluorinated methacrylates (p.4 ll.10-28) as disclosed in Tournilhac. Moreover, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. MPEP § 2144.06 (citations omitted). Bitler teaches using SCC polymers with widely ranging T_p that is 20 degrees Celsius above the temperature of use, and one of ordinary skill in the art would appreciate that using an additional SCC polymer with T_p of 50 °C or greater would allow preparation of compositions that are able to withstand higher storage and processing temperatures.

Response to Arguments

6. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

7. The declaration under 37 CFR 1.132 filed on May 17, 2011 (the Auguste declaration) is insufficient to overcome the rejection of claims 35 – 37, 40 – 42, 44 – 63, 65 – 76, and 78 based upon Bitler in view of Tournilhac as set forth herein concerning the current, amended claims. First it is noted that Applicant seeks consideration of the Auguste declaration with respect to the amended claims (Remarks at 12, second paragraph) which require the semi-crystalline polymer to be side chain crystallizable polymers (SCC polymers), i.e., not main-chain crystallizable polymers.

The Auguste declaration is insufficient to overcome rejection of the pending, amended claims because it compares Composition 1, represented as according to the present claims, against comparative composition comprising Engage 8400 (the Auguste declaration at para.7). Tournilhac does teach using Engage 8400 and the prior Office action noted this fact since the prior claims were not limited to SCC polymers. However Applicant represents Engage 8400 as a main chain crystallizable polymer (Remarks at 14, second para.). Accordingly the Auguste declaration has no probative value for overcoming rejection of the current, amended claims drawn to compositions comprising SCC polymers.

Art Unit: 1611

8. Moreover, as discussed above teaching of Tournilhac is in no way limited to the so-called main chain crystallizable polymers, but encompasses semi-crystalline homo- and copolymers with a melting point preferably below 110 °C (paras.0015-21), including perfluorinated or fluorinated homo- and copolymers, including perfluorinated (meth)acrylic homopolymers or copolymers, perfluorinated homo- or vinylic copolymers, and fluorinated poly(ether vinylic) homo or olefin copolymers (para.0092) which are semi-crystalline polymers that include side chain crystallizable polymers.

9. Applicant further argues that Bitler mentions "in several places that it is undesirable to have the temperature of the polymers be too far above the temperature of use" as discussed regarding Example 2, and thus the skilled person would not have combined the SCC polymers of Bitler with high-melting polymers (Remarks at 15-16).

This argument is unpersuasive. First, the only SCC in Example 2 had a T_p above 50 °C (p.9, Table 1), and thus Bitler is not speaking to compositions comprising a combination of SCCs of low- and high- melting points. Second, concerning Example 3 Bitler states "[i]n Example 3, **the T_p of the polymer was in the preferred range, but the polymer was less effective than the polymers of the invention used in Examples 1 and 5-8**" (p.9 ll.8-10, emphasis added). Thus a close reading of Bitler will suggest to one of ordinary skill in the art that T_p of the SCC polymer is not the sole controlling factor which determines the resulting composition's structure; rather it is the combination of components as well as the suitable SCC polymers. Notably, the SCC polymers in Example 5 which Bitler describes as "effective", had T_p of 50 °C, a high-

Art Unit: 1611

melting SCC polymer as recited in the instant claims. Finally, as noted above Bitler teaches that "depending on the expected temperature of use, Tp may be from 0-150 °C. generally 10-100 °C, for example 40-80 °C" (p.6 ll.26-28). One of ordinary skill in the art therefore would have been motivated to combine the teachings of Bitler and Tournilhac and prepare compositions comprising oily phase and one or more SCC polymers with Tp ranging in the 40-80 °C, 10-100 °C, 0-150 °C as well as a colorant and a volatile oil.

CONCLUSION

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1611

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. SARAH PARK whose telephone number is 571-270-5258. The examiner can normally be reached on weekdays excluding alternate Wednesdays, 9 a.m. - 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HSP/
Examiner, Art Unit 1611

/SHARMILA G. LANDAU/
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